

### REMARKS

Reconsideration and entry of the amendment are respectfully requested. Claims 1 to 8 are currently pending, and no claims have been amended.

The Office Action mailed July 3, 2001 addressed Claims 1 to 8. Claims 1 to 8 were rejected.

The specification was objected to by the Examiner as failing to provide proper antecedent basis for the claimed subject matter, and correction was required. The Examiner stated that in claim 7, an outer cover layer having a modulus in a range of about 1,000 to about 30,000 psi is not in the specification.

The present application is a continuation of several applications which relate back to U.S. Patent Application Serial No. 08/556,237, filed on November 9, 1995. Original claim 6 (initially mislabeled as claim 8 in the specification) specifies that the outer cover layer has a flex modulus in a range of about 1,000 to about 30,000 psi. Specifically, claim 6 reads as follows:

[8.] 6. A multi-layer golf ball comprising:

a spherical core;

an inner cover layer molded over said spherical core to form a spherical intermediate ball, said inner cover layer comprising an ionomeric resin having no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and having a modulus of from about 15,000 to about 70,000 psi;

an outer cover layer molded over said spherical intermediate ball to form a multi-layer golf ball, the outer layer comprising a non-ionomeric elastomer selected from the group consisting of polyester elastomer, polyester, polyether polyurethane and polyester amide, **said outer cover layer having a modulus in a range of about 1,000 to about 30,000 psi.** (Emphasis added.)

Since the limitation directed to the flex modulus of the outer cover was included in original claim 6 (labeled as claim 8 when filed), it is part of the specification. A copy of pages 48 to 50 of the original specification directed to claims 1 to 6 is attached for the Examiner's convenience. Applicant therefore respectfully submits that the

specification provides proper antecedent basis for the claimed subject matter, therefore Applicant respectfully requests that the objection be reconsidered and withdrawn.

Claims 1 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Proudfit in view of Nakamura. The Examiner stated that Proudfit discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The Examiner further stated that the inner cover layer is made from an ionomer and the outer cover is made from an elastomer, but Proudfit does not disclose an inner cover layer with a carboxylic acid. The Examiner further stated that Nakamura teaches an ionomer comprising 10 to 20% by weight of an alpha, beta-unsaturated carboxylic acid. The Examiner concluded that since the addition of acids to ionomers is very common, one of ordinary skill in the art would have added an acid to the inner cover layer of Proudfit to increase the flexibility of the composition.

Proudfit discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from an ionomer, and the outer cover layer is made from an elastomer. Proudfit does not disclose an inner cover layer with a carboxylic acid. Additionally, the elastomer of the outer cover layer of Proudfit is a natural or synthetic balata (see column 5, line 15 to column 6, line 31). Applicant's invention is not directed to a golf ball comprising a balata outer cover layer. The cover of Applicant's golf ball comprises a polyurethane. The present application, at page 2, lines 11 to 14, distinguishes the use of a polyurethane cover over a balata cover, such as the cover claimed by Proudfit. Specifically, the specification states: "Despite all the benefits of balata, balata covered golf balls are easily cut and/or damaged if mis-hit. Golf balls produced with balata or balata-containing cover compositions therefore have a relatively short lifespan." Since, as discussed above, the primary reference, Proudfit, is deficient because it does not disclose a golf ball with an outer cover layer comprising polyurethane, the addition of Nakamura as a secondary reference does not cure this deficiency. Neither Proudfit alone as the primary reference, nor in combination with Nakamura, produces a golf ball comprising an inner cover layer comprising at least one ionomer resin having less than 16 % acid and an outer cover layer comprising a polyurethane. Adding the ionomer of Nakamura to Proudfit does not produce

Applicant's golf ball, which comprises an inner cover layer having less than 16 % acid and an outer cover layer comprising a polyurethane.

For at least these reasons, Applicant respectfully submits that claims 1 and 3 are not obvious under 35 U.S.C. § 103(a) over Proudfit in view of Nakamura. Applicant therefore respectfully requests that the rejection of claims 1 and 3 under 35 U.S.C. § 103(a) as obvious over Proudfit in view of Nakamura be reconsidered and withdrawn.

Claims 1 to 8 were rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1 to 8 of U.S. Patent No. 6,210,293. The Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the '293 patent and the present application claim golf balls comprising a core, an inner cover layer and an outer cover layer, and the inner cover layer is made from ionomer and the outer cover layer is made from a polyurethane.

Although Applicant respectfully disagrees with the Examiner, in an effort to hasten prosecution, Applicant herein submits a Terminal Disclaimer which disclaims the terminal portion of any patent granting from the instant application, as required under MPEP § 1490. Applicant respectfully submits that this overcomes the rejection.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 8. Applicant respectfully requests allowance of claims 1 to 8, the claims currently pending.

Respectfully submitted,

Michael J. Sullivan

Customer No. 24492  
Phone: (413) 322-2937

Date: September 19, 2001

By: Michelle Bugbee  
Michelle Bugbee, Reg. No. 42,370  
Spalding Sports Worldwide  
Attorneys for Applicant  
425 Meadow Street  
P.O. Box 901  
Chicopee, MA 01021-0901

cc: Richard M. Klein, Esquire (SLD 2 0035-3-3-1-1-1)